

indicated by the cover sheet with which the application was filed). When the formal drawings are submitted all handwritten portions will be more formalized.

By the present amendment changes have been made to various claims in order to ensure compliance with 35 USC 112, that is to take into account the points raised in paragraph 4 on pages 3 through 5 of the Action. By the present amendment, claim 1 has been amended to provide proper antecedent basis for all terms therein, and the word "generally" has been removed. Claim 2 has been revised to indicate that it is the location as well as the non-reflectivity of the material that eliminates reflection. Claim 8 has been amended to remove the size limitation and claim 9 has been amended to remove the "primarily black" language. Claim 17 has been amended to refer to the finish, size, location, and non-reflectivity. Claim 18 has been amended to delete the reference to the black or dark color. To this extent it is believed that the objections to the claims have been overcome.

To the extent that it is alleged that further revision of the claims is necessary in order for them to be definite within the purview of 35 USC 112, reconsideration is requested. For example, the purpose of the claims is not to answer all possible questions with respect to a particular construction. In re Johnson, 194 USPQ 187, 195 (CCPA 1977). The purpose of the specification is to provide detailed information, and the claims are merely to define what the invention is. Therefore answers to the questions, for example, posed on page 4 of the Action are not necessary in the claims to make them definite. With regard to the "direct or indirect" light limitation, that merely refers to all light, and whether

there would be any difference in the construction if only direct light was being dealt with is irrelevant. The purpose of the claims is for someone to know whether or not they would be infringing, and one of ordinary skill in this art -- to whom the application claims are directed -- would clearly and unequivocally know that viewing the present claims.

With respect to the objection to the use of the term "substantially", it is respectfully submitted that the objection is not well taken because there are literally hundreds of thousands of patents (if not millions) issued with that term in the claims. As one example see claim 1, third line, of U.S. patent 4,105,483 of record which uses the word "substantially" in defining a non-porous substrate.

The term "substantially" is commonly used in patent claims to prevent an infringer from avoiding literal infringement by minor changes, and is universally considered definite within the purview of 35 USC §112. See NRDC v Great Lakes Carbon, 188 USPQ 327, 333 (D. Del. 1975), wherein the court held:

"The term 'substantially' in this element of the claim is one commonly used in patents to prevent the avoidance of literal infringement by minor changes which do not themselves cause a loss of benefit of the invention. 1 A. W. Deller, Patent Claims §305 (2d ed. 1971). Indeed, there is authority for the proposition that its presence should always be implied in every claim, even when not introduced. Musher Foundation, Inc. v Alba Trading Co., Inc., 150 F.2d 885, 889, 66 USPQ 183, 186-187 (2d Cir. 1945)."

With respect to the limitation in claims 9 and 19 regarding the size of the logo, there is nothing indefinite about what is recited there. There is no requirement that something be defined in numerical terms. Definition in non-numerical terms, which is commonly referred to as "definition by result" is entirely

acceptable. This is true not only with respect to the logo size limitation, but also with respect to the limitation regarding the material and its location and size to substantially eliminate the reflection of light into the human's eyes, for example as recited in claim 17. In this regard attention is directed to In re Halleck, 164 USPQ 647, 649 (CCPA 1970):

"The claims were also rejected by the examiner as 'too broad and \*\*\* functional at the exact point of alleged novelty' because the claims failed to set out specifics regarding proportions of substances to be used. We have set out above our view that the 'exact point' of novelty lies in the discovery that the agents in question stimulate growth in animals, not in the amount used other than that it be an amount effective to stimulate growth. The functional term 'an effective amount \*\*\* for growth stimulation' is not objectionable where the amount as such is not critical and its use has been approved in many cases. See In re Caldwell, 50 CCPA 1464, 319 F.2d 254, 138 USPQ 243 (1963)." (Emphasis added)

Therefore it is believed that all of the claims are in clear conformance with 35 USC 112.

Reconsideration is respectfully requested of the obviousness rejection of claims 1, 2, and 8 through 12 in paragraph 6 on page 5 of the previous Action. It is impermissible to ignore the language "predefined clearly demarcated geometric shape" when evaluating these claims. First of all it should be pointed out that the terms may not be dissected individually and -- given a different interpretation of the reference applying each term -- to see whether or not the invention ensues. Rather the terminology must be considered as a whole.

Claims are to be given their broadest reasonable interpretation during prosecution, with emphasis on the term "reasonable". In re Royka 180 USPQ 580, 582, 583 (CCPA 1974). This reasonable interpretation must also be consistent

with the specification. In re Saether, 181 USPQ 36, 39 (CCPA 1974). Here considering the limitations together it is clear that "predefined" cannot merely be ignored but modifies all of the other language in the claim relating to the invention. As the enclosed copy of a page from Webster's Third International Dictionary makes clear, something is "predefined" if it is defined or determined in advance. One applying conventional eye black does not define or determine a clearly demarcated geometric shape in advance. Rather one merely smears it on at the top of the cheek bone where the reflection is most likely to occur and accepts whatever form it is applied in. This is clear from the Sports Illustrated cover page. The terms "predefined clearly demarcated geometric shape which provides a non-verbal communication to others" is specifically described in the specification as clearly distinguishing from conventional eye black.

Also, in the rejection on page 6 of the Action the language of claim 1 is being misinterpreted by alleging that the conventional use of eye black provides a non-verbal communication that someone is a participant in an athletic event. Claim 1 does not call for the non-reflective material to provide a non-verbal communication to others, but rather its predefined clearly demarcated geometric shape. The shape of the eye black on the Sports Illustrated cover provides no non-verbal communication. The invention, on the other hand, as indicated by the illustrated embodiments, does communicate something to others, such as "I Support the Panthers Team", "I Wear 'HIGH' Shoes", etc.

The suggestion that the application of eye black in a particular predefined shape would be a matter of obvious design is mere speculation. Eye black has

been around for decades. Despite this fact, and despite the fact that advertising messages of virtually all types have been provided associated with athletic contests (billboards in stadiums, scoreboard messages, logos on TV screens during World Cup matches, identifying logos on shirts, shoes, and pants of athletic contests participants, etc.), no one heretofore has provided the invention. This is a clear indication of unobviousness and the mere incantation of the words "obvious design choice" cannot overcome these facts.

It is also noted that in the rejections of claims in paragraph 6 numerous limitations of the claims have been ignored. For example there is absolutely no teaching whatsoever of the clearly demarcated predefined geometric shape being a sports apparel or equipment manufacturer distributor's logo as set forth in claims 8 and 9. Despite the fact that such logos have been put on virtually everything in the past they have not been positioned where eye black is conventionally positioned as according to the invention. Further there is absolutely no teaching of such a positioning of the particular predefined shapes set forth in claims 11 or 12, or the dull or matte color to have the wavelength set forth in claim 10. Therefore the dependent claims are even more clearly allowable.

Reconsideration is also respectfully requested of the rejection of claims in paragraph 7 on pages 6 through 8 of the previous Action as unpatentable over conventional temporary tattoos such as exemplified by the Team Dynamics, J.B. Marketing, and Anderson brochures supplied by the applicant. There are two enormous differences between what is recited in claims 1 and 17 and the temporary tattoo prior art applied. One is that the temporary tattoos are typically

not of the type of dull, matte, non-reflective material provided according to the invention. The second is that they are not dimensioned or positioned so as to cover the area of reflective light location on a wearer's cheek, that is on the upper cheekbone. It is clear that this has been recognized in the previous Action, but is explained away by -- with the benefit of applicants' invention in mind -- pointing out how one might modify the existing brochures and information.

It should be emphasized that one cannot ignore the clear statement, both explicit and implicit, made in the references, that the temporary tattoos are not to be applied in the area of the eye merely because applicants have shown for their purposes they may be.

Also the last sentence in the second full paragraph on page 7 of the Action is erroneous. The Team Dynamics brochure and the J.B. Marketing brochure do not show temporary tattoos applied as close to the eyes as would be applied in the present invention. For example the cover sheet of the Team Dynamics brochure shows the tattoo applied at the area of the side of the cheekbone, the most prominent position of the face. That is where the skin bulges out and is most easily seen, and that is obviously the preferred location for placing a tattoo if the only purpose is to use it as a decoration. However where one has as another purpose for using it [i.e. to prevent reflectance of light into the eyes], then rather than placing the tattoo on the prominently extending cheek portion, one places it as set forth in the claims, namely underneath the eyes where it will prevent incident light from being reflected into the eyes. In none of the positions of the tattoos in the Team Dynamics brochure will the tattoo -- even if it were dull and

matte rather than reflective (which it is) -- prevent incident light from being reflected into the eyes.

The same is true of the J.B. Marketing brochures. The only illustration the undersigned can find in the J.B. Marketing brochures for temporary tattoos applied to the face are those applied to little children's faces, and in those situations they are remote from the under eye area, taking seriously the explicit caution provided in the J.B. Marketing materials that the tattoos should not be applied near the eyes. The Anderson illustrations are to the same effect. The illustrations in the Anderson reference show the "cheek cheers" applied, as would be expected, at prominent locations at the sides of the cheeks, and not where recited in the instant application claims.

What is implicitly taught by all of the brochures that show the temporary tattoos? That one is not to place the temporary tattoos under the eyes in the position called for in the claims at issue. Not only is this implicitly taught it is explicitly stated in the J.B. Marketing materials. Therefore the invention is clearly unobvious for this reason alone.

Also, an alleged conflict between what the references show and what is perceived to be the general "matte" appearance of tattoos cannot serve as the basis for the obviousness rejection. The claims at issue do not merely call for a matte appearance. Rather they call for -- in the case of both claims 1 -- a non-reflective colored and finished material. Therefore even if a real tattoo is considered to be "matte", that does not in any way, shape or form teach the claimed invention. Even though matte real tattoos may have reflectively colored portions.

Further, it is clear from all of the advertisements submitted that in any situation where a decal that forms the temporary tattoo is applied to the face it is illustrated as reflective and brightly colored. This is clear from an inspection not only of the Anderson's and Team Dynamics brochures which show all reflective (shiny) finish, brightly colored decals, but also the J.B. Marketing brochures which, even though they show in other locations decals that are matte (for example on the arm of the male model in the J.B. Marketing brochure that says "Value Pack Program" at the top and has a picture of a man and woman each with arm tattoos covering up the vast majority of the cover), that is not true for the face tattoos. Applicants' understanding is that there is a clear reason for this. Marketers of these decals do not want them to look like real tattoos when applied to the face. The reason for that is that real tattoos on a face would, certainly in at least American society, be associated with low class and/or motorcycle gang individuals. The manufacturers would not want their products restricted to such groups or identified with such groups, and therefore they make their decals brightly colored with highly reflective finishes. This is completely clear from the numerous decals and photographs, all associated with facial application of decals, in the Team Dynamics brochure.

Further, with respect to claims 17 through 19, it is not the "intended use" of the decals recited therein which distinguish them from the prior art. It is the specific limitations. In particular the limitations of being non-reflective colored and finished material of sufficient size and reflectivity to substantially eliminate the reflection of incident light, and dimensioned to substantially cover the area of



a reflective location on the cheek at which incident light would be reflected into a human's eyes. This is a specific limitation, not a statement of intended use, and it is not taught by the applied references.

Also the fact that the shape (although not necessarily size) of the temporary tattoo illustrated in figure 6 of applicants' drawings was taken from the Team Dynamics brochure is not in any way, shape or form an indication of unobviousness because the invention recited in many of the claims does not distinguish from the conventional decals in shape, but rather in reflectivity, size, and/or position (use). As a matter of fact this illustrates the unobviousness of the invention! The panther illustrated in the Team Dynamics brochure has undoubtedly been a popular shape for many years, and in fact is only one of a handful of decals in the entire Team Dynamics brochure that is so popular that it is offered in four or more colors. Yet despite this no one heretofore thought to make it non-reflective and dimension it and position it so that it could be used like conventional eye black. This indicates unobviousness not obviousness.

It would appear that the invention is being rejected here because it is simple. However its simplicity is an indication of its unobviousness, not obviousness. In this regard see In re Sporck, 133 USPQ 360, 363, wherein the CCPA held:

"Once appellant's solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions is often times the very thing that is not obvious before they are made. This court, in

In re Osplack, 39 CCPA 932, 195 F.2d 921, 93 USPQ 306, 308, stated:

We think this case is one of that category of inventions which, when viewed after disclosure and explanation by an applicant, seem simple and such as should have been obvious to those in the filed. Yet this does not necessarily negative invention or patentability. Goodyear Tire & Rubber Co., Inc. et al v Ray-O-Vac Company, 321 U.S. 275, 60 USPQ 386; In re DeLancey, 34 CCPA 849, 159 F.2d 737, 72 USPQ 477. Indeed, simplicity may even be some evidence of invention. Baldwin-Southwark Corporation v Tinius Olsen Testing Mach. Co. et al, 88 F.2d 910, 32 USPQ 366.

The fact that the invention seems simple after it is made is not determinative of the question of obviousness. If this were the rule, many of the most beneficial patents would be stricken down. *If those skilled in the mechanical art, are working in a given field and have failed to discover a certain new and useful improvement, the one who first makes the discovery frequently has done more than make an obvious improvement which would have suggested itself to a mechanic skilled in the art, and such an invention is entitled to the grant of a patent thereon.* Expanded Metal Co. v Bradford, 214 U.S. 366." (Emphasis added.)

All of the claims are clearly unobvious over the conventional decal brochures.

Further there are numerous limitations of the dependent claims that are not even remotely suggested by the references, nor are they even discussed in the Action. For example there is no teaching whatsoever of the particular shapes of claims 8 through 13, 18, or 19. The provision of such shapes have numerous advantages compared to the prior art. For example the sports equipment manufacturers or distributors logos are a highly appealing way of directly

advertising one's product, although subtly. For example visualize the situation where at the Super Bowl the starting teams are being introduced and, as always happens, the camera focuses in on each of the player's faces. Suppose that several of the players have their eye black in the predefined shape of the "Low" shoe manufacturer logo. What is that exposure worth to the manufacturer? Shoe manufacturers conventionally pay millions of dollars a year to athletes just to wear their shoes, which are much less visible to TV spectators than would be the eye black on a player's face during player introductions. The invention is the epitome of an unobvious invention.

In conclusion it is believed that all of the claims clearly patentably distinguish from the art, therefore early passage of the subject application to issue is earnestly solicited.

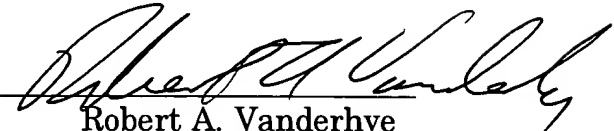
Should any small matters remain outstanding it is requested that the undersigned attorney be given a call so that such matters may be worked out and the application placed in condition for allowance without the necessity of another Action and amendment.

• COMISKEY et al  
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Respectfully submitted,

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